

REMARKS

Claims 1-22 are still pending in this application. The Examiner is thanked for the telephone interview of August 17, 2005 in which the finality of the previous Office Action was discussed.

Request for Reconsideration of Finality of Previous Office Action under MPEP 706.07(d)

The previous Office Action was made final in that "Applicant's amendment necessitated the new ground of rejection." Applicant respectfully requests that the Examiner reconsider the finality of that action for the following reasons.

Firstly, Applicant submits that the claims were not amended in any meaningful sense. Claim 1 was amended to add the phrase "from said client computers" to the fourth element, and claim 12 was amended to add the phrase "information from said client computers" to the fourth step. But, these added phrases do not add new limitations to the claim. The limitations clarified by the addition of these phrases were already present in the claims and were supposedly searched during the first Office Action.

Before amendment, claim 1 required in its third element "a scan log of information which is sent back from each client user." Thus, the scan log is sent back from the client computer of each user. The fourth element makes it clear where the scan log of information is going: before amendment, the fourth element required "a virus tracking server for receiving the scan log information." Thus, the virus tracking server receives the scan log information which is sent back from each client user having a client computer. This limitation of the claim is quite clear upon a reading of the claim before amendment. Applicant added the phrase "from said client computers" in order to assist with an understanding of the claim and to make it crystal clear where the scan log is coming from, but the phrase certainly did not add a new limitation to the claim. Claim 12 was modified in a similar fashion and likewise had no new limitation added to it.

It is the undersigned's understanding that the Examiner is taking the position that any amendment to a claim must necessarily result in a second Office Action being made final. But, there is no support in case law, Patent Office rules or in the MPEP for the assertion that any amendment to a claim must mean that a second Office Action must be made final. A minor

clarifying amendment that does not add a new limitation certainly does not require that the Examiner undertake a new search.

Secondly, MPEP 706.07(a) states that a second action on the merits shall be final, except where the Examiner introduces a new ground of rejection that is not necessitated by applicant's amendment of the claims. Above it is pointed out that applicant's minor amendments did not introduce a new limitation that required the Examiner to undertake a new search. In fact, the Examiner was obligated to introduce a new ground of rejection because the first Office Action did not adequately reject the claims based on the two original references. In other words, the new ground of rejection in the supposedly final Office Action was necessitated by deficiencies in the first Office Action.

Taking claim 1 for example, the first Office Action alleges that the second element ("at least one antivirus scanning server") is present in *Hailpern et al.* (first Office Action, page 2). But, the final Office Action retreats from that position and suddenly claims that this second element is not disclosed in *Hailpern et al.* (final Office Action, page 3). The final Office Action then introduces a new reference, *Tso*, and a new ground of rejection and alleges that this second element is present in *Tso*.

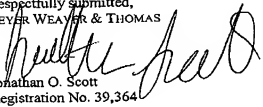
Further, the first Office Action does not allege that the third element ("a scan log of information") is present in either of the cited references. The final Office Action agrees with this position and states that this third element is not disclosed in *Hailpern et al.* The final Office Action then introduces a new ground of rejection and alleges that this third element is present in *Tso*. Applicant can also point out further deficiencies in the first Office Action regarding the fourth element of claim 1 and corresponding steps of claim 12.

In conclusion, it is respectfully submitted that the most recent Office Action cannot be made final because the minor clarifying amendments made by Applicant did not introduce any new features or limitations requiring the Examiner to perform a new search. In fact, the Examiner was required to perform a new search and introduce a new ground of rejection because the first Office Action did not adequately reject the claims. Therefore, Applicant submits that the final rejection was premature and requests that the finality of that rejection be withdrawn.

Applicant respectfully requests that the Examiner indicate to the undersigned a decision on this matter before September 4, 2005 so that Applicant can take any necessary action before

the next deadline. If the Examiner believes a telephone conference would in any way expedite prosecution, please do not hesitate to telephone the undersigned at (612) 252-3330.

Respectfully submitted,
BEYER WEAVER & THOMAS



Jonathan O. Scott
Registration No. 39,364

BEYER WEAVER & THOMAS, LLP
P.O. Box 778
Berkley, CA 94704-0778

Telephone: (612) 252-3330
Facsimile: (612) 825-6304